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EXAMINER

OSTRUP, CLINTON T

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/725,837
Filing Date: December 01, 2003
Appellant(s): REID, TONY

Dana Buschmann
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 1, 2008 appealing from the Notification of Non-Compliant Appeal Brief and Advisory Action Office action mailed June 2, 2008.

1. Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

2. Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

The Board of Patent Appeals and Interferences affirmed the obviousness rejection of claims 1-10. Those claims were different from those currently pending. See: the *Ex parte Reid*, decision mailed January 8, 2007.

3. Status of Claims

The statement of the status of claims contained in the brief is correct.

4. Status of Amendments

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

Regarding Appellant's proposed Examiner's Amendment, an Examiner's Amendment is not an available remedy at this point in prosecution.

5. Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the

appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The brief is deficient because Independent claim 1, claims “a first sleeve... being configured to be slid over the full length of the limb,” not that it “slides over the full length of the limb” as described by appellant. Claim 1 also claims “a second sleeve... being configured to be slid wholly over the entire length of the first sleeve,” not that it “slides over the full length of the first sleeve” as described by appellant.

In regard to Independent claim 5, it claims an innermost therapeutic pressure sleeve (TPS)... configured to be slid over the entire length of the arm” not that it “slides over the entire length of the arm” as described by appellant. Claim 5 also claims “a second sleeve... being configured to be slid wholly over the entire length of the TPS...” not that it “slides over the entire length of the therapeutic pressure sleeve” as described by appellant.

6. Grounds of Rejection to be reviewed on Appeal

The appellant’s statement of the grounds of rejection to be reviewed on appeal is correct.

7. Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

8. Evidence Relied Upon

814,795	MEYERS	3-1906
5,171,211	DEASY et al.	12-1992

9. Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers (814,795) in view of Deasy, Jr. (5,171,211)

Regarding claims 1, 5 and 10, Myers discloses a system for applying pressure (“compressive covering” disclosed on line 9) to a body limb, said system comprising: a first innermost therapeutic pressure sleeve 1 (TPS) comprising a cylindrical body open at both ends (fig. 1), having a foam lining with ridges 3 formed over an inner surface, and being configured to be slid over the full length of the limb (figs. 1 and 3) and to apply an inward pressure onto the limb; a second sleeve 4 comprising a cylindrical body open at both ends (fig. 1) and configured to be slid over the first sleeve and to apply additional inward pressure onto the limb; except for the second sleeve having the same length as the first sleeve for applying additional inward pressure along the full length of the limb.

However, Deasy discloses a system for applying pressure to a body limb comprising a first sleeve 18 configured to be slid over an arm from the shoulder to the wrist (fig. 7) and to apply an inward pressure onto the limb; a second sleeve 46 configured to be slid over substantially the entire length of the first sleeve (best seen in fig. 7) and to apply additional inward pressure along the length of the limb (col. 4, lines 35-45).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Myer's second sleeve to have a sufficient length so that it can be configured to be slid substantially over the entire length of the first sleeve, as taught and suggested by Deasy, for the purpose of increasing the effectiveness of the compression therapy in the treatment of edema and providing improved the user's stamina (Deasy, col. 4, lines 60-66).

With respect to the limitation "the second sleeve being configured to be slid wholly over the entire length of the first sleeve and having the same length as the first sleeve", since Deasy already teaches that the second sleeve is configured to be slid over most of the length of the first sleeve (best seen in fig. 7), therefore it would have been an obvious matter of design choice to modify the size of the second sleeve of Myers to be the same length as the first sleeve, for the purpose of covering the limb completely with both sleeves and thus enhancing the effectiveness of the compression therapy, and since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Furthermore, figs. 1, 2A and 2B of the present application appear to illustrate the inner sleeve 18 and outer thin fabric compression sleeve 40 having the same length, with the outer sleeve being slid over the entire length of the inner sleeve. Fig. 6, in contrast, illustrates a

different embodiment of the outer sleeve wherein a shortened sleeve 40a, which is identical in construction to sleeve 40 but of a shorter length than sleeve 18, can be used with sleeve 18 (present specification, p. 14). The present specification further discloses at page 14, that "a plurality of sleeves 40a, (which can be of various lengths equal or shorter than sleeve 18), can be applied one over another at various locations on sleeve 18."

Therefore, absent a teaching as to criticality that the second sleeve being configured to be slid *wholly* over the entire length of the first sleeve, this particular arrangement is deemed to have been known by those skilled in the art since the instant specification and evidence of record fail to attribute any significance (novel or unexpected results) to a particular arrangement. *In re Kuhle*, 526 F.2d 553,555,188 USPQ 7, 9 (CCPA 1975).

Re claims 2 and 6-7, Myers discloses a third sleeve 4 ("4 represents a series of outer encircling bands" as disclosed on lines 42-46) configured to be slid over the second sleeve and to apply additional inward pressure onto said limb (fig. 1 shows an inner sleeve 1 and two outer sleeves 4), except for the first sleeve having a low coefficient of friction.

However, Deasy teaches that the sleeve may be made of flexible relative heavy and strong elastic material (col. 3, lines 30-40), and therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made, to select a flexible material that also has a low friction characteristic to assist in removing the sleeve, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Re claims 4 and 9, Deasy teaches that "each component part or portion of the garment is made of elastic material and is sized so as to be compressive on the body of the user" (col. 3,

lines 46-48) for the purpose of reducing the symptoms of edema (col. 4, lines 65-66), and therefore depending on the size of the user and the limb the device is placed on, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to configure the Myers' sleeve such that it would be capable of providing a wide range of radially inward pressure, including slight pressure or greater pressure in the range of 5 mmHg to 30mmHg.

Re claims 3 and 8, Myers' second and third sleeves 4 appear to be thin bands (fig. 1) and therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made, to select a thin flexible fabric material to make these outer sleeves, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

10. Response to Arguments

A. Obviousness

1. Applicable Law of Obviousness.

The examiner agrees with appellant's description on how to establish *prima facie* obviousness and that when combining references, the combination of the references cannot render the disclosed device inoperable. However, appellant has not presented any arguments or evidence under this subsection that the proposed modification would render the prior art invention inoperable.

Moreover, as stated in the *Ex parte Reid* decision (appended hereto), "the recognition in both Deasy and Myers of the advantages in a body compression system of providing both a base level of generally uniform compression and a level of added compression in localized regions as

desired indicates that the systems of Deasy and Myers are more alike and more similar to appellant's invention in both structure and purpose than the appellant would have us believe."

See: page 8, lines 10-15. Thus, the references are combinable and the modification of the device of Myers, using a secondary sleeve of Deasy would not render the prior art device inoperable.

2. Independent claim 1 and 5 are not obvious in view of Myers and Deasy.

Regarding appellant's argument that the modification of the size of the secondary sleeve to be the same length as the first sleeve or therapeutic sleeve is not an obvious matter of design choice because none of the cited references, even when combined, teach or suggest this limitation. The examiner respectfully disagrees.

Myers discloses forming an elastic bandage for a limb (See: col. 2, lines 65-86) with secondary encircling bands. Deasy teaches a sleeve that is configured to substantially cover a first sleeve and that it is possible to only use selected parts of the garment where necessary (See: col.5, lines 19-25 and figure 7).

A medical practitioner treating a patient would treat an injured portion of the body. If a leg, an arm, or any portion of a limb including the arm portion from the wrist to the shoulder required treatment, a medical practitioner would treat that portion of the body. Myers teaches an elastic bandage, with encircling bands that can be formed to fit a limb of a patient. Deasy was used to replace the encircling bands with an elongated secondary sleeve that provides a covering for the elastic bandage and enhances the effectiveness of the compression therapy. Thus, it would have been an obvious design choice by the skilled artisan to modify the size of the elastic bandage and corresponding outer sleeve to fit the portion of the body requiring treatment.

Regarding appellant's argument that there is nothing in Deasy that teaches or suggests that the integral sleeve may extend from the shoulder all the way down to the wrist, the rejection is based on the combination of Myers and Deasy. Myers discloses an elastic bandage for application to limb and Deasy teaches tubular arm portions that extend from the wrists upwardly beyond the elbow joint to form an overlap with the sleeves. See: Deasy, figure 7.

Regarding appellant's argument that if Deasy were modified by extending the sleeves to completely overlap [the first sleeve or therapeutic pressure sleeve] the modification would render Deasy unsatisfactory for its intended purposes, the examiner respectfully disagrees.

The material used to form the sleeves of Deasy is an elastic material that is flexible and stretches and although an elongated sleeve would inherently cause a minor amount of additional friction, it would not create an insurmountable amount of friction to render the device inoperable.

Regarding appellants argument that Deasy does not teach or suggest a second sleeve configured to be slid over the entire length of the first sleeve, the examiner maintains that the sleeve taught by Deasy substantially covers a limb and the mere modification of the size of the device, taught by the combined references, is a modification within the skill of one of ordinary skill in the art. Moreover, a skilled artisan would be motivated to modify the size of the device to treat the portion of the body that is need of treatment.

Regarding appellant's argument that modifying the sleeves to completely overlap [the first sleeve or therapeutic pressure sleeve] is a modification that directly contradicts the Deasy disclosure in that the sleeves should overlap only at the joint and that such a modification would render the Deasy garment unsatisfactory for its intended purposes, as any circulatory benefits of the Deasy garment might be lost by the modification, has not been found convincing.

Deasy teaches "[I]t is also possible to only use selected parts of the garment where necessary" and it would be obvious to one having ordinary skill in the art to replace the short encircling bands of Myers, with an outer sleeve having additional therapeutic compression properties, as taught by Deasy because they increase the effectiveness of the compression therapy in the treatment of edema and provide improved user stamina. The beads described by Deasy are merely rolled up ends of material that provide additional compression at the end points of the material, which further suggests that it would be easy to modify the size of the outer sleeve by rolling the ends to the desired length. See: col. 4, lines 24-30.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The device of Myers is being modified by the teachings of Deasy. Myers discloses an elastic bandage for the treatment of a limb with secondary outer encircling bands. Deasy is being used to substitute those secondary outer encircling bands with an elongated sleeve that provides compression therapy and is formed of a flexible, elastic material that is configured to be slid over substantially the entire length of the arm. See: Deasy, figure 7 and *Ex parte Reid*, page 6, last paragraph – page 7, first paragraph.

3. Dependent claims 2-4 and 6-10 are likewise not obvious.

Regarding appellant's argument that because Myers and Deasy fail to teach or suggest every limitation of the independent claims, the cited references likewise fail to teach or suggest

every limitation of the dependent claims and are therefore not obvious, the examiner respectfully disagrees.

As discussed above, the cited references taken together with the knowledge of one having ordinary skill in the art, independent claims 1 and 5 are obvious.

4. Criticality

Regarding appellant's argument that criticality is not required, as appellants are entitled to present claims directed to one or more particular embodiments, the examiner respectfully agrees.

However, appellant's invention was determined to be obvious over the teachings of the combined references and the modification of the sleeves as an obvious variation of the teachings of the combined references, and well within the skill of an artisan.

Thus, absent some unexpected result that might be obtained by having a second sleeve "configured to be slid wholly over the entire length of the first sleeve," this feature was determined to be an obvious, non-critical variation of the teachings of the combined references. Since appellant has not provided any evidence to the contrary, the modification is still determined to be an obvious variation of the device of the combined references and well within the skill of one having ordinary skill in the art.

5. The Board's previous Decision considered substantively different claims.

The examiner respectfully agrees with appellant's argument that the claims are different from those previously presented to the Board of Patent Appeals and Interferences.

11. Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Clinton Ostrup/

Examiner, Art Unit 3771

Conferees:

/Justine R Yu/

Supervisory Patent Examiner, Art Unit 3771

/Janet C. Baxter/

TC 3700 TQAS